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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,051	03/16/2004	Christopher K. Yakes	061300-0216A	9306
7590	10/19/2005			
James A. Wilke Foley & Lardner Suite 3800 777 East Wisconsin Avenue Milwaukee, WI 53202-5306			EXAMINER GIBSON, ERIC M	
			ART UNIT	PAPER NUMBER
			3661	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,051	<b>Applicant(s)</b> YAKES ET AL	
	<b>Examiner</b> Eric M. Gibson	<b>Art Unit</b> 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 44-94 is/are pending in the application.
- 4a) Of the above claim(s) 44-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 83-94, drawn to a method of transferring information to potential customers over the Internet, classified in class 705, subclass 27.
  - II. Claims 44-82, drawn to an electric vehicle, classified in class 701, subclass 22.
- a. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of transferring the data to potential customers over the Internet does not require the specific details of the electric vehicle. The claimed method steps of obtaining information, entering the information, and transmitting the information apply generically to any product and the specific recital that the information is about an electric vehicle is not required in order to implement the claimed method steps. The subcombination has separate utility such as an electric vehicle.

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b. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. Claims 44-82 have been previously withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant elected claims 39-41 in the reply filed on 1/14/2005. Newly added claims 83-94 are directed to an invention similar to originally elected claims 39-41 and are therefore now pending as the elected claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 83-94 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pulliam et al. (US006609108B1).

a. Per claim 83, Pulliam teaches a method of transferring selected vehicle data including generating selected data representative of a vehicle (column 11, lines 26-35), entering the selected data on a terminal connected to the Internet through a server (column 11, lines 1-3), and transmitting the data from the terminal to the Internet

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through the server (column 11, lines 4-25). While Pulliam does not teach the specific vehicle specifications included in the claim, the content of the data bears no relational nexus to the method claim. The specific data is not required to fulfill the claimed steps of: 1) generating data representative of a vehicle, 2) entering the data on an Internet-connected terminal, and 3) transmitting the data from the terminal to the Internet. There is no function being performed by the method that is unique to the type of vehicle data specified. However, in the alternative, transmitting specific vehicle data would have been obvious to one of ordinary skill in the art at the time of the invention. The problem to be solved is transmitting information related to a vehicle over the Internet to customers. The method of accomplishing this was known to one of ordinary skill in the art at the time of the invention. Therefore, specifying the particulars of *any* vehicle would be obvious to one of ordinary skill in the art at the time of the invention.

b. Per claim 84, Pulliam teaches the terminal is a computer (column 7, line 51).

c. Per claims 85 and 86, Pulliam teaches that the vehicle data includes pricing and product configuration data (column 11, lines 9-10).

d. Per claim 87, Pulliam teaches a method including communicating data representative of a vehicle over a network and "using" the data (column 11, lines 1-35). While Pulliam does not teach the specific vehicle specifications included in the claim, the content of the data bears no relational nexus to the method claim. The specific data is not required to fulfill the claimed steps of: 1) communicating over a network data representative of a vehicle and 2) using the data. There is no function being performed

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by the method that is unique to the type of vehicle data specified. However, in the alternative, transmitting specific vehicle data would have been obvious to one of ordinary skill in the art at the time of the invention. The problem to be solved is transmitting information related to a vehicle over the Internet to customers. The method of accomplishing this was known to one of ordinary skill in the art at the time of the invention. Therefore, specifying the particulars of *any* vehicle would be obvious to one of ordinary skill in the art at the time of the invention.

e. Claims 88 and 89 fail to further limit the method of independent claim 87. There are no further limitations directed towards the *method*, only to *structure*. The method of communicating data related to the specifics of the vehicle configuration is disclosed by Pulliam (see column 11, lines 9-10).

f. Per claim 90, Pulliam teaches that the network is the Internet (column 11, line 3).

g. Per claim 91, Pulliam teaches a method including providing Internet access to data representative of a vehicle and "using" the data (column 11, lines 1-35). While Pulliam does not teach the specific vehicle specifications included in the claim, the content of the data bears no relational nexus to the method claim. The specific data is not required to fulfill the claimed steps of: 1) providing Internet access to data representative of a vehicle and 2) using the data. There is no function being performed by the method that is unique to the type of vehicle data specified. However, in the alternative, transmitting specific vehicle data would have been obvious to one of ordinary skill in the art at the time of the invention. The problem to be solved is

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transmitting information related to a vehicle over the Internet to customers. The method of accomplishing this was known to one of ordinary skill in the art at the time of the invention. Therefore, specifying the particulars of *any* vehicle would be obvious to one of ordinary skill in the art at the time of the invention.

h. Claims 92 and 93 fail to further limit the method of independent claim 91. There are no further limitations directed towards the *method*, only to *structure*. The method of communicating data related to the specifics of the vehicle configuration is disclosed by Pulliam (see column 11, lines 9-10).

i. Per claim 94, Pulliam teaches a method including communicating data representative of a vehicle over a network and “using” the data (column 11, lines 1-35). While Pulliam does not teach the specific vehicle specifications included in the claim, the content of the data bears no relational nexus to the method claim. The specific data is not required to fulfill the claimed steps of: 1) communicating over a network data representative of a vehicle and 2) using the data. There is no function being performed by the method that is unique to the type of vehicle data specified. However, in the alternative, transmitting specific vehicle data would have been obvious to one of ordinary skill in the art at the time of the invention. The problem to be solved is transmitting information related to a vehicle over the Internet to customers. The method of accomplishing this was known to one of ordinary skill in the art at the time of the invention. Therefore, specifying the particulars of *any* vehicle would be obvious to one of ordinary skill in the art at the time of the invention.

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j. Claims 95 and 96 fail to further limit the method of independent claim 94.

There are no further limitations directed towards the *method*, only to *structure*. The method of communicating data related to the specifics of the vehicle configuration is disclosed by Pulliam (see column 11, lines 9-10).

k. Per claim 97, Pulliam teaches that the network is the Internet (column 11, line 3).

### ***Response to Arguments***

5. Applicant's arguments filed 7/29/2005 have been fully considered but they are not persuasive. The Applicant's invention is transmitting information about a vehicle over the Internet. The type of data being transmitted in no way changes the operation of the method. The method of transmitting product information over the Internet was well known at the time of the invention. Furthermore, transmitting vehicle information over the Internet was also known at the time of the invention. At least one well known website (Autobytel.com) was already in operation at least as far back as 1996.

Including information related to any type of vehicle would have been obvious to one of ordinary skill in the art at the time of the invention. The data is transmitted over the Internet like any other type of data, regardless of its content.

### ***Conclusion***

6. The references of record and not relied upon are considered pertinent to applicant's disclosure. Brockman et al. (US006125356A) teaches a portable sales



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presentation system with selective scripted seller prompts. Harrington (US005895454A) teaches an integrated interface for vendor/product oriented Internet websites. Salmon et al. (US005592375A) teaches a computer-assisted system for interactively brokering goods or services between buyers and sellers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Gibson whose telephone number is (571) 272-6960. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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